REMARKS

In the Office Action, the Examiner rejected claims 75 and 90-101 under 35 U.S.C. § 103(a) as being unpatentable over Reichler (U.S. Patent No. 5,578,270) in view of Tseung (U.S. Patent Pub. No. 2003/0099573) and rejected claims 102-113, 116-118, 120, and 121 under 35 U.S.C. § 103(a) as being unpatentable over Reichler in view of Tseung and Ammann et al. (U.S. Patent Pub. No. 2005/0233370). The Examiner also provisionally rejected claims 75, 90-113, 116-118, 120, and 121 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 14-19, 21-23, 25, 27-30 and 32-36 of copending Application No. 10/538,964, and claims 1-71 of copending Application No. 10/539,308. Finally, the Examiner rejected claims 75, 90-113, 116-118, 120, and 121 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 7,875,245.

By this Amendment, Applicants amend claims 75, 102, and 118. Claims 75, 90-113, 116-118, 120, and 121 remain pending. Of these claims, claims 75, 102, and 118 are independent.

I. 35 U.S.C. §103(a) rejection of claims 75 and 90-101 over Reichler in view of Tseung

Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 75 and 90-101 over Reichler in view of Tseung. The Office Action asserts that Reichler discloses all of the elements of independent claim 75, except for drawers capable of facilitating the insertion and removal of objects during the processing protocol. The Office Action, however, cites Tseung as allegedly disclosing this feature. Furthermore,

the Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reichler with the slide drawer of Tseung to arrive at the present claims. Applicant respectfully disagrees. The cited references, taken alone or in combination, fail to disclose all of the features of amended claim 75, including at least "a moveable robotic member for dispensing fluid on the at least one carrier; wherein the at least one carrier is inserted or removed during the processing protocol without interrupting the fluid dispensing of the robotic member."

The Office Action, at page 3, acknowledges that Reichler does not disclose this feature, but asserts, at page 4, that Tseung teaches that "slides and reagent containers are provided within drawers that allow for the removal of slides and reagent containers without interrupting the movement of the robotic member." Tseung, however, explicitly teaches an apparatus with only a single slide drawer. The single slide drawer of Tseung does not provide a structure capable of permitting at least one carrier to be inserted or removed during the processing protocol without interrupting the fluid dispensing of the robotic member, as recited by amended claim 75. The removal of the single slide drawer of Tseung would remove all of the slides at once, thus preventing the robotic member from continuing its fluid dispensing. Tseung, therefore, does not disclose this feature.

The Office Action asserts, however, at page 10, that "it is well within the purview of one of ordinary skill to provide each of the Reichler sample carriers 78, 80, 82, 84 with a separate and independently addressable drawer." The assertion that this modification of Reichler, however, "**is** well within the purview of one of ordinary skill," employs impermissible hindsight reasoning. The MPEP, at §2145.X.A, provides that a

judgment on obviousness must only take into account knowledge that was within the level of ordinary skill in the art at the time the claimed invention was made, and not include knowledge gleaned only from applicant's disclosure.

In the instant case, a person of ordinary skill in the art at the time of the invention would not have found it obvious to modify the apparatus of Tseung and apply it to Reichler because the references do not identify any advantages or problems to be solved by doing so. The Office Action's hypothetical combination of Reichler and Tseung is not simply a combination of known elements, but a combination of elements subsequently modified in a manner not suggested or contemplated by the cited references.

Tseung, discloses, at paragraph [0037], that "[t]he drawers 68, 70 faciliated [sic] the exchange of slides 12 while limiting the impact of the exchange on the controlled environment within the processing space 18." Tseung further discloses, at paragraph [0034], that, if a user wishes to add slides during processing, "[t]he execution may be paused to add slides 12 . . . to the slide racks 20 and to integrate their staining protocols with the staining protocols of the slides 12 pending when the staining process was paused." Thus, Tseung discloses an apparatus designed to solve the limited problem of minimizing environmental exchange between the controlled processing space and the ambient environment. Providing additional slide drawers would not serve to better solve this problem, and would only make the apparatus of Tseung more complicated and prone to failure, through, for instance, the requirement of a more complex system of seals between the drawers and the apparatus cover. Moreover, contrary to the Office's position, Tseung teaches away from the claimed invention indicating that the execution

may be paused to add slides or slide racks. Tseung, therefore, provides no reason for the modifications proposed by the Office Action.

The apparatus of Reichler, as the Office Action acknowledges, does not permit the exchange of slides during the dispensing of fluid by robotic member 190, or through drawers, and therefore cannot provide any suggestion to modify the apparatus of Tseung in the manner hypothesized by the Office Action.

Reichler and Tseung, therefore, taken alone or in combination, do not disclose each and every feature of amended claim 75. No prima facie case of obviousness has been established. Claims 90-101 depend from claim 75, and are likewise not obvious in view of the cited references.

II. 35 U.S.C. §103(a) rejection of claims 102-113, 116-118, 120, and 121 over Reichler in view of Tseung and Amman.

Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 102-113, 116-118, 120, and 121 over Reichler in view of Tseung and Amman. The cited references, taken alone or in combination, do not disclose all of the features of independent claims 102 and 118, including at least "a moveable robotic member for dispensing fluid on the at least one carrier; wherein the at least one carrier is inserted or removed during the processing protocol without interrupting the fluid dispensing of the robotic member."

The Office Action cites Amman as allegedly disclosing an apparatus capable of regulating the temperature of a plurality of reagents. Amman does not, however, disclose or suggest "a moveable robotic member for dispensing fluid on the at least one carrier; wherein the at least one carrier is inserted or removed during the processing

protocol without interrupting the fluid dispensing of the robotic member." As discussed above, Reichler and Tseung also do not disclose or suggest this feature.

Because the cited references, taken alone or in combination, do not disclose all of the features of independent claims 102 and 118, no prima facie case of obviousness is established. Claims 103-113, 116, 117, 120, and 121 depend from claims 102 and 118, and are also not obvious in view of the cited references for at least the same reasons.

III. Double Patenting Rejections

In the Office Action, the Examiner provisionally rejected claims 75, 90-113, 116-118, 120, and 121 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 14-19, 21-23, 25, 27-30 and 32-36 of copending Application No. 10/538,964, and claims 1-71 of copending Application No. 10/539,308. The Examiner also rejected claims 75, 90-113, 116-118, 120, and 121 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent no. 7,875,245.

Applicants do not necessarily agree with the characterizations or assertions in the Office Action with respect to the double patenting rejections. The claims are patentably distinct and the double patenting rejection should be withdrawn.

However, in order to expedite prosecution, Applicants submit herewith a Terminal Disclaimer to obviate the double patenting rejection. Accordingly, Applicant respectfully requests withdrawal of the double patenting rejections of claims 75, 90-113, 116-118, 120, and 121.

The filing of the terminal disclaimer, however, in no way manifests an admission by Applicant as to the propriety of the double patenting rejection. See M.P.E.P. § 804.02 citing *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991).

IV. Conclusion

Applicants respectfully submit that the proposed amendments of claims 75, 102, and 118 merely clarify the claim language, and do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, any subsequent rejection of these claims, including new grounds, have not been necessitated by the amendments presented, and should therefore not be made final.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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